



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BELL, BOYD & LLOYD LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

Paper No. 18

COPY MAILED

NOV 21 2003

OFFICE OF PETITIONS

In re Application
Hughes-Baird et al.
Application No. 09/686,308
Filed: October 11, 2000
Atty Docket No. 0112300/144

:
:
: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed August 25, 2003. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from fifty (50) days to ninety-one (91) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein. The patent term adjustment has been corrected to thirty-three (33) days (rather than the requested ninety-one days).

Applicants are given **thirty (30) days** to respond to this decision. No extensions of time will be granted under § 1.136(a).

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is thirty-three (33) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 13, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 50 days. On August 25, 2003, applicants timely submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is ninety-one (91) days. Applicants dispute the reduction of 41 days for applicant delay in replying to the Notice to File Missing Parts of Application mailed November 30, 2000. Applicants state that their response to the Notice was received in the Office on January 25, 2001. In support thereof, applicants submit a copy of their date-stamped return postcard. Applicants state that otherwise the adjustments of record for Office delay (147 days) and the reduction of record for applicant delay (56 days) in the application at the time of mailing of the Notice of Allowance are correct.

¹ PALM records indicate that the Issue Fee, due by September 16, 2003, was received in the Office with a mailroom date of September 15, 2003.

Applicants specifically state that the patent issuing from this application is not subject to a terminal disclaimer.

A review of the application history reveals that the adjustments of 96 and 51 days (for a total of 147 days) and the reduction of 56 days are both correct. However, as asserted by applicants, the patent term adjustment should not have been reduced by forty-one days for applicant delay. Applicants' response to the Notice to File Missing Parts of Application mailed November 30, 2000, is of record in the application with a date of receipt by the Office of January 25, 2001, reflecting timely filing for purposes of compliance with 37 CFR 1.704(b). Furthermore, the response included a complete reply to the Notice. Thus, the Office should not have entered the date that the instant application was complete as April 10, 2001 and should not have assessed applicants a delay of forty-one (41) days. The response was timely filed within the three-month period under 37 CFR 1.704(b) and accordingly, applicants' delay should have been assessed as 0 days. Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts.

However, a review of the application history reveals that the patent term adjustment should have been further reduced pursuant to § 1.704(b). Specifically, applicants' response to the final rejection mailed January 29, 2003, was not received by the Office until June 26, 2003. Thus, this response was not timely filed within the three-month period under 37 CFR 1.704(b) and applicants should have been assessed a reduction of 58 days for the delay in excess of three months (i.e., the number of days in the period beginning on April 30, 2003 and ending on June 26, 2003).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is thirty-three (33) days (147 days reduced by 114 (56 + 58) days).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will forward the file to the Office of Patent Publication so that a patent can be issued in a timely manner.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.

Karin Ferriter
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen